

Attorney Docket No.: J3679(C)
Serial No.: 10/520,891
Filed: June 5, 2006
Confirmation No.: 4944

REMARKS

By this Amendment, applicants have amended independent claims 1 and 7 to more clearly define, in addition to the specific hydroxyl compounds already recited, characteristics relating to (a) chain length, (b) branching and (c) lack of aromaticity which clearly differentiate in a slightly more generic way the compounds of the invention. As discussed below, the amendments are intended to highlight specific selection distinctions which are not recognized by references cited against the present invention.

More specifically, the claims have been amended to recite that compounds of the invention:

- (a) must have a chain length of greater than 4 carbons to 10 carbons or less (supported at page 6, lines 1-3);
- (b) that they have one methyl side chain and no other branching (supported at page 6, lines 6-8); and
- (c) that they are not aromatic (supported at page 5, line 28).

As will be discussed below, none of these criticalities, let alone the effect of such compounds specifically in repairing or restoring damaged hair exhibiting, for example, cuticle or protein loss, fiber stiffness, fiber brittleness or fragile split ends, is disclosed or predictable based on the reading of Japanese Yamamoto reference.

Accordingly, claims present in the subject application are claims 1, 2, 4 and 13-19 as currently amended.

At page 2 of the Office Action, the Examiner has rejected claims 17-19 under 35 USC § 102(b) as allegedly anticipated by JP 407330551 to Yamamoto et al.

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(hereinafter, "Yamamoto"). Yamamoto is said to disclose a method of treating and conditioning hair with hair treatment composition comprising 0.5-50% of a solvent which may be a 5-8 carbon monohydric aliphatic alcohol. Such solvent is said to allow hair refining ingredient to permeate inside of the hair. Example 19 is said to disclose composition comprising dimethylammonium chloride, siloxane polymers, cetyl alcohol and benzyl alcohol. The rejection is respectfully traversed for reasons set forth below.

The claims of the present invention, as amended, highlight the fact that the damage repairing or restoring hydroxyl compounds of the invention (specific compounds having been previously recited) are all characterized by specifically noted characteristics. That is, the hydroxyl compounds: (1) must have chain length 4 to 10 carbons; (2) have one methyl side chain and no other branching; and (3) are not aromatic. It is these specific types of compounds which have been found, entirely unpredictably, to provide damage repair or restoration to hair with cuticle or protein loss (as well as other noted benefits) when they are used in the leave-on, conditioner compositions (claim 17) or anionic-containing shampoo compositions (claim 1) of the invention.

Yamamoto, by contrast, recognizes neither the specific type of compounds which would provide these benefits or, for that matter that this type of benefit is provided at all. In other words, it cannot be forgotten that claim 17 (and/or claim 1) are method claims, i.e., claims identifying a novel benefit unrecognized by the art. Moreover, the novel benefit is not provided by a broad class of compounds recognized in the art, but by a specifically selected class of compounds. It is the specifically selected characteristics of these compounds which are responsible, entirely unpredictably, for these benefits.

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With regard to the rejection under 35 USC §102, the reference to 2-methyl-1-pentanol as organic solvent at paragraph 0023 has nothing to do with the class of compounds of the subject invention. As indicated by the Examiner, solvents used in the reference could also readily be pentanol and hexanol. There is no recognized criticality. Further, there is clearly no recognition of a compound like 2-methyl-1-pentanol having any benefit, for example, for repairing or restoring hair follicles. This method is clearly not disclosed in Yamamoto and thus this clearly cannot be a rejection under 35 USC §102. Further, as these benefits are completely unpredictable, this also cannot be a rejection under 35 USC §103.

Reviewing Examples 17-20 of the translation, it is also noted that not one of these examples uses a solvent falling within the class of compounds required by the subject invention to provide noted benefits. Thus, in Example 17, solvent seems to be mixture of phenyl ethanol and 1,3-butylene glycol (a compound which is aromatic and does not have "one methyl chain and no other branching"); in Example 18 it appears to be dimethylbenzylcarbinol; in Example 19, it seems to be benzyl alcohol; and in Example 20, it seems to be dimethylbenzyl carbinol.

Again, there is absolutely no recognition of the specific class of compound required by our invention, let alone the unpredictable benefit provided by such class of compound.

At page 3 of the Office Action, the Examiner has rejected claims 1, 2, 4 and 13-16 under 35 USC §103 as allegedly unpatentable over Yamamoto; and, as applied to claims 17-19 above, and further in view of Hoeffkes.

With regard to the rejection of claims 1, 2, 4, and 13-16, arguments over Yakamoto are as above. Specifically, Yamamoto fails to identify the specific class of

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compounds used in the subject invention. Further, Yamamoto fails to recognize, and it is completely unpredictable, that such compounds have the repair and restoration benefits noted (e.g., against cuticle or protein loss, excessive fiber stiffness; fiber brittleness and breakage or frayed split ends). Indeed, the unpredictability is even that much greater relative to claim 1 in that Yamamoto does not appear to be concerned at all with anionic surfactant containing shampoo compositions.

With regard to Hoeffkes, this reference is related to compositions comprising (a) water-soluble ionic polymers; and (b) water-soluble salts of di- or tri-carboxylic acids. The extremely broad concept of adding hair conditioning components to rinse or shampoo does nothing to teach or suggest the specific compositions and/or methods of the invention. That is, Hoeffkes does nothing to remedy the fundamental deficiencies of Yamamoto, i.e., no recognition of specific class of compounds or recognition that use of such compounds has specifically recited beneficial effects.

At page 4 of the Office Action, last paragraph, the Examiner states that Yamamoto unambiguously teaches that the purpose of the prior art is to enhance benefit of cationic hair conditioning agents to hair by using the swelling effect of the organic solvent.

First, if the purpose of solvent is to help better deliver the quat salt, this says nothing about the uniqueness (i.e., criticalities) of the solvent in the way defined by our invention. As noted above, there is no teaching or suggestion that "solvent" must have the defined chain length, have one methyl side chain, and be non-aromatic. Indeed, none of the examples in Yamamoto meet this definition.

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Further, the specific benefits (against cuticle/protein loss, stiffness, brittleness, breakage, etc.) resulting from use of a specific class of components is simply not disclosed.

In short, although the organic solvents of Yamamoto might in theory be beneficial in some other compositions, the solvents are not the same as the class of solvents we use and there is no recognition whatsoever of the specific benefit provided by our class of components.

In view of the amendments and discussions above, it is respectfully requests that the Examiner withdrawn all rejections of the claims and that claims, as currently amended, be allowed.

If a telephone conversation would be of assistance in advancing the prosecution of the present application, applicants' undersigned attorney invites the Examiner to telephone at the number provided.

Respectfully submitted,

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